



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,728	06/30/1999	TOSHIHISA SAWADA	P18153	8274

7055 7590 06/16/2005

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/343,728

Applicant(s)

SAWADA, TOSHIHISA

Examiner

Houshang Safaipour

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Limitation “a file converter configured to convert image data into a predetermined plurality of file formats, the data of each file format including all of the image data” is not described in the specification.

Therefore, the amended claims have not been examined on the merits and examiner maintains his previous rejection based on the best understanding of the claims .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Patent No. 6,028,679) and in view of European Patent Application (EP 0 835 011 A1).

Regarding claim 19, Murphy discloses an image data transmitting apparatus comprising:
a file converter configured to convert image data into a plurality of file formats, the data of each file format including all of the image data (col. 3, line 25-55);

Murphy does not explicitly disclose a memory configured to store an e-mail address of recipient and an address of a server corresponding to the e-mail address of the recipient; a transmitter configured to determine the server corresponding to the recipient when e-mail address of the recipient is input, to transmit to the server the data in the plurality of file formats and to transmit to the recipient, by e-mail, the address of the server in which the image data is stored. However, (EP 0 835 011 A1) discloses these features (col. 7, line 5 through col. 8, line 10 and col. 13, line 25 through col. 14, line 22 and fig. 22). These two references are combinable because they are both address networks facsimile communications. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine the two systems to provide capability of transmitting plurality of file formats.

Regarding claim 20, Murphy discloses the apparatus according to claim 19, wherein the plurality of types of file formats comprise a JPEG file, a tiff file or a bit map file (col. 3, lines 25-47).

Regarding claims 22, 24 and 25-27 arguments analogous to those presented for claim 19 are applicable to claims 22, 24 and 25-27.

Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Patent No. 6,028,679) and in view of European Patent Application (EP 0 835 011 A1) and further in view of JP Publication 09-231121.

Regarding claim 21, neither Murphy nor (EP 0 835 011 A1) explicitly disclose the

Art Unit: 2622

apparatus according to claim 19, wherein a file converter converts image data in units of a page. EP discloses such an apparatus [0040-0043]. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine EP's apparatus with that of Murphy, because this addition would enhance the design.

Regarding claim 23, the arguments analogous to those presented for claim 21 are applicable to claim 23.

Additional rejection for claim 19:

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al. (U.S. Patent No. 6,167,469) and in view of European Patent Application (EP 0 835 011 A1).

Regarding claim 19, Safai et al. discloses an image data transmitting apparatus comprising:

a file converter configured to convert image data into a plurality of file formats, the data of each file format including all of the image data (col. 13, line 66 through col. 14 line 24);

Safai et al. does not explicitly disclose a memory configured to store an e-mail address of recipient and an address of a server corresponding to the e-mail address of the recipient; a transmitter configured to determine the server corresponding to the recipient when e-mail address of the recipient is input, to transmit to the server the data in the plurality of file formats and to transmit to the recipient, by e-mail, the address of the server in which the image data is

Art Unit: 2622

stored. However, (EP 0 835 011 A1) discloses these features (col. 7, line 5 through col. 8, line 10 and col. 13, line 25 through col. 14, line 22 and fig. 22). These two references are combinable because they are both address transmission of digital images. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine the two systems to provide capability of transmitting plurality of file formats.

Additional rejection for claim 19:

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP Publication 09-231121 and in view of European Patent Application (EP 0 835 011 A1).

Regarding claim 19, JP Publication 09-231121 discloses an image data transmitting apparatus comprising:

a file converter configured to convert image data into a plurality of file formats, the data of each file format including all of the image data [0040-0043];

JP Publication 09-231121 does not explicitly disclose a memory configured to store an e-mail address of recipient and an address of a server corresponding to the e-mail address of the recipient; a transmitter configured to determine the server corresponding to the recipient when e-mail address of the recipient is input, to transmit to the server the data in the plurality of file formats and to transmit to the recipient, by e-mail, the address of the server in which the image

Art Unit: 2622

data is stored. However, (EP 0 835 011 A1) discloses these features (col. 7, line 5 through col. 8, line 10 and col. 13, line 25 through col. 14, line 22 and fig. 22). These two references are combinable because they are both address transmission of digital images. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine the two systems to provide capability of transmitting plurality of file formats.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Houshang Safaipoor
Patent Examiner
June 10, 2005


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600